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Thomas A. O'Rourke Bodner & O'Rourke LLP 425 Broadhollow rd. #108 Melville, NY 11747			DEVORE, PETER T	
			ART UNIT	PAPER NUMBER
			3751	

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/776,955	BREIDENBACH ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Peter deVore	3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 4/20/06.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2-15,17-28 and 31-48 is/are pending in the application.
  - 4a) Of the above claim(s) 48 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2-15,17-28 and 31-47 is/are rejected.
- 7) Claim(s) 15,33,41 and 43 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11 February 2004 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/20/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

The indicated allowability of claim 28 is withdrawn in view of the newly discovered reference to Penn. Rejections based on the newly cited reference(s) follow.

***Information Disclosure Statement***

The information disclosure statement filed 4/20/06 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Copies of two of the foreign references cited were not received and those two citations have been lined through on the initialed IDS. All of the other cited documents have been considered and initialed.

***Election/Restrictions***

This application contains claims directed to the following patentably distinct species: Species 1, directed to an applicator whose driving member is a flat disk having parallel top and bottom surfaces; and Species 2, directed to an applicator whose driving member has a top surface angled with respect to the bottom surface. The species are independent or distinct because the different structures function in different ways to drive the product.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 2-15, 17-28, and 31-46 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

During a telephone conversation with Mr. O'Rourke on 6/13/06 a provisional election was made with traverse to prosecute the invention of Species 1, claims 2-15, 17-28, and 31-47. Affirmation of this election must be made by applicant in replying to this Office action. Claim 48 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Drawings***

The drawings are objected to because Figures 12A-12C in the drawings submitted on 2/11/04 are informal. Note that the formal replacement drawings submitted on 9/27/04 did not include replacement Figures 12A-12C. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

Claim 15 is objected to because of the following informalities: in line 2, "is has" apparently should be "has". Appropriate correction is required.

Claim 33 is objected to because of the following informalities: in line 1, "is a disk is" apparently should be "is a disk located". Appropriate correction is required.

Claim 41 is objected to under 37 CFR 1.75 as being a duplicate of claim 25.

Claim 43 is objected to because of the following informalities: at the end of the last line, "in said." apparently should be "in said reservoir." Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-19 and 33-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is indefinite because it depends from cancelled claim 16. For prior art purposes it is assumed to depend from claim 31. Note however that if the claim depended from claim 31 it would have an antecedent basis problem with "the drive means" and a double recitation problem with "a screw means".

Claim 33 recites the limitation "the drive means" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 33 apparently re-introduces "a screw means" which had already been introduced as "a screw means" in claim 32 from which it depends. This double introductory recitation renders it unclear as to whether the claim is referring to the same "screw means" or a second "screw means" and renders the claim indefinite.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 26 of USPN 6607323. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons: pending claim 45 is slightly broader than patent claim 26 and is

thus “anticipated” by patent claim 26. A pending claim that is anticipated by a previous claim is considered to not be patentably distinct therefrom.

Claims 15, 17-19, 31-35, and 44 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22-24 of USPN 6607323 in view of USPN 5879095 (Gueret). Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. Regarding pending claims 31, 15, and 17 (pending claim 15 depends from pending claim 31 and pending claim 17 is assumed to depend from pending claim 31 as discussed above), patent claim 22 recites an applicator having all of the features of pending claims 31, 15, and 17, except for the tip having an inner and outer surface which the orifice extends between, or that the drive means/driving member contacts an inner surface of the reservoir, or that the thickness of the sidewall of the reservoir is constant. However, the Gueret reference discloses a similar applicator whose tip (comprising portions 31, 3, and 6) has an outer and inner surface (see Fig. 1) which orifice (61 and opening formed by tip portion 3) extends between for a convenient stop surface for the drive means (the inner surface) and for a convenient surface for contacting the product to a user’s lips (the outer surface), whose driving member contacts an inner surface of the reservoir (see Fig. 2) to prevent leakage of product, and whose thickness of the sidewall of the reservoir is constant (see Fig. 2) for simple fabrication of the reservoir such that it does not require multiple wall thicknesses. It would have been obvious to modify the applicator of patent claim 22 such that the tip has an outer and inner surface which the orifice extends between in view of Gueret for a

convenient stop surface for the drive means and for a convenient surface for contacting the product to a user's lips, such that the driving member contacts an inner surface of the reservoir in view of Gueret to prevent leakage of product, and whose thickness of the sidewall of the reservoir is constant in view of Gueret for simpler fabrication of the reservoir such that it does not require multiple wall thicknesses. Furthermore, respective pending claims 18 and 19 (which depend from pending claim 17) are substantially the same as or broader than respective patent claims 23 and 24 (which similarly depend from patent claim 22). Regarding pending claims 32 and 33 (pending claim 33 depends from pending claim 32), patent claim 22 recites an applicator having all of the features of pending claims 32 and 33, except for the tip having an inner and outer surface which the orifice extends between, or that the drive means/driving member has a product contact surface that contacts the inner surface of the tip to remove as much product as possible from the reservoir. However, the Gueret reference discloses a similar applicator whose tip (comprising portions 31, 3, and 6) has an outer and inner surface (see Fig. 1) which orifice (61 and opening formed by tip portion 3) extends between for a convenient stop surface for the drive means (the inner surface) and for a convenient surface for contacting the product to a user's lips (the outer surface), and whose driving member 41 has a product contact surface which contacts the inner surface of the tip to remove as much product as possible from the reservoir (see Fig. 4) for maximizing efficient usage of the product in the applicator. It would have been obvious to modify the applicator of patent claim 22 such that the tip has an outer and inner surface which the orifice extends between in view of Gueret for a convenient stop surface for the drive

means and for a convenient surface for contacting the product to a user's lips, and whose driving member has a product contact surface which contacts the inner surface of the tip to remove as much product as possible from the reservoir in view of Gueret for maximizing efficient usage of the product in the applicator. Furthermore, respective pending claims 34 and 35 (which depend from pending claim 33) are substantially the same as or broader than respective patent claims 23 and 24 (which similarly depend from patent claim 22). Regarding pending claim 44, patent claim 27 recites an applicator having all of the features of pending claim 44, except for the tip having an inner and outer surface which the orifice extends between. However, the Gueret reference discloses a similar applicator whose tip (comprising portions 31, 3, and 6) has an outer and inner surface (see Fig. 1) which orifice (61 and opening formed by tip portion 3) extends between for a convenient stop surface for the drive means (the inner surface) and for a convenient surface for contacting the product to a user's lips (the outer surface). It would have been obvious to modify the applicator of patent claim 27 such that the tip has an outer and inner surface which the orifice extends between in view of Gueret for a convenient stop surface for the drive means and for a convenient surface for contacting the product to a user's lips.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 17-19, 31-35, 43, 46, and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Gaebel.

Regarding claim 31, the Gaebel reference discloses an applicator capable of applying pasty product to a user's lips comprising a body 11a, a hollow product reservoir 16, a tip (10 and 11b) having an outer surface and an inner surface (see Fig. 2), an orifice extending between the inner and outer surface (passageway between the inner and outer surface of the tip), a driving member 24 which contacts the inside surface of the reservoir and rides along screw means 21, the thickness of the reservoir sidewall being constant (see Fig. 2), and wherein the user can view the color of the product in the reservoir (via window 13). Regarding claim 15, the product reservoir side wall is round (see Fig. 3). Regarding claim 17, the Gaebel drive means is disk 22 supporting screw means/driving member 24. Regarding claims 18 and 19, the screw means is prevented from turning by guide member 13 which extends from the interior wall of the reservoir (see Fig. 3) which mates with a recess in the driving member (see Fig. 3). Regarding claim 32, the Gaebel reference discloses an applicator capable of applying pasty product to a user's lips comprising a body 11a, a hollow product reservoir 16, a tip (10 and 11b) having an outer surface and an inner surface (see Fig. 2), an orifice extending between the inner and outer surface (passageway between the inner and outer surface of the tip), a driving member 24 which has a product contact surface which contacts the inner surface of the tip to remove as much product as possible from the reservoir (see Fig. 3), and a screw means 21, and wherein the user

can view the color of the product in the reservoir (via window 13). Regarding claim 33, the Gaebel drive means is disk 22 supporting screw means/driving member 24. Regarding claims 34 and 35, the screw means is prevented from turning by guide member 13 which extends from the interior wall of the reservoir (see Fig. 3) which mates with a recess in the driving member (see Fig. 3). Regarding claim 43, the Gaebel reference discloses an applicator capable of applying pasty product to a user's lips comprising a body 11a, a hollow product reservoir 16, a tip (10 and 11b) having an outer surface and an inner surface (see Fig. 2), an orifice extending between the inner and outer surface (passageway between the inner and outer surface of the tip), a driving member 24 which has a product contact surface generally parallel to the inner surface of the tip (see Fig. 2), and a screw means 21, and wherein the user can view the color of the product in the reservoir (via window 13). Regarding claim 46, the Gaebel reference discloses an applicator capable of applying pasty product to a user's lips comprising a body 11a, a hollow product reservoir 16, a tip (10 and 11b) having an outer surface and an inner surface (see Fig. 2), an orifice extending between the inner and outer surface (passageway between the inner and outer surface of the tip), and a means for discharging/driving member 24 which has a flat product contact surface across its entire surface, and wherein the user can view the color of the product in the reservoir (via window 13). Regarding claim 47, the Gaebel reference discloses an applicator capable of applying pasty product to a user's lips comprising a body 11a, a hollow product reservoir 16, a tip (10 and 11b) having an outer surface and an inner surface (see Fig. 2), an orifice extending between the inner and outer surface

(passageway between the inner and outer surface of the tip), and a means for discharging/driving member 24 which is a flat disk having parallel top and bottom surfaces (see Fig. 2), and wherein the user can view the color of the product in the reservoir (via window 13).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5, 15, 17, 18, 20, 24, 31-34, 36, 40, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5879095 (Gueret) in view of USPN 5842802 (Lang).

Regarding claims 31, 2-4, and 20, the Gueret reference discloses an applicator for applying product to a user's lips comprising a body 2 with a hollow reservoir (portion other than tip portions 31 and 3 containing product P, see Fig. 2), a tip (comprising portions 31, 3, and 6) having an outer and inner surface (see Fig. 1), an orifice (61 and opening formed by tip portion 3), a driving member 41 which contacts the inside of the reservoir (see Fig. 2), screw means 51, the sidewall of the reservoir having a constant thickness (see Fig. 2), and a cap 8, but does not disclose that a user can view product in the reservoir via a viewing window at the top, a transparent reservoir exterior, and a hand hold adhered to the reservoir comprising a window. However, the Lang reference

discloses a similar applicator having a cap 34a with transparent top and sidewalls (see col. 4, lines 40-48) and a reservoir exterior with a hand hold 30 adhered to the reservoir, the reservoir/hand hold optionally transparent (see col. 2, lines 33-37) thus forming viewing windows in the cap and hand hold so that the user can see the contents of the applicator and more easily grip the applicator. It would have been obvious to employ a viewing window at the top and sides of the Gueret cap and a transparent reservoir exterior/adhered hand hold on the Gueret reservoir thus forming viewing windows in the cap and hand hold in view of Lang so that the user can see the contents of the applicator and more easily grip the applicator. Regarding claim 5, although Gueret remains silent as to the material of the cap, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cap from PETG, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In Re Leshin, 125 USPQ 416. Regarding claim 15, the reservoir has a round side wall (see Gueret Fig. 5). Regarding claim 17, the Gueret applicator further includes disk 7. Regarding claim 18, the Gueret applicator further includes guide member 43. Regarding claim 24, the tip in the embodiment of Fig. 9 includes a perimeter canal 15 (see col. 8, lines 14-19). Regarding claims 32 and 36, the Gueret reference discloses an applicator for applying product to a user's lips comprising a body 2 with a hollow reservoir (portion other than tip portions 31 and 3 containing product P, see Fig. 2), a tip (comprising portions 31, 3, and 6) having an outer and inner surface (see Fig. 1), an orifice (61 and opening formed by tip portion 3), a driving member 41

which has a product contact surface which contacts the inner surface of the tip to remove as much product as possible from the reservoir (see Fig. 4), and a screw means 51, but does not disclose that a user can view product in the reservoir or a hand hold adhered to the reservoir comprising a viewing window. However, the Lang reference discloses a similar applicator having a reservoir exterior with a hand hold 30 adhered to the reservoir, the reservoir/hand hold optionally transparent (see col. 2, lines 33-37) thus forming a viewing window in the hand hold so that the user can see the contents of the applicator and more easily grip the applicator. It would have been obvious to employ a transparent reservoir exterior/adhered hand hold on the Gueret reservoir thus forming a viewing windows in the hand hold in view of Lang so that the user can see the contents of the applicator and more easily grip the applicator. Regarding claim 33, the Gueret applicator further includes disk 7. Regarding claim 34, the Gueret applicator further includes guide member 43. Regarding claim 40, the tip in the embodiment of Fig. 9 includes a perimeter canal 15 (see col. 8, lines 14-19). Regarding claim 44, the Gueret reference discloses an applicator for applying product to a user's lips comprising a body 2 with a hollow reservoir (portion other than tip portions 31 and 3 containing product P, see Fig. 2), a tip (comprising portions 31, 3, and 6) having an outer and inner surface (see Fig. 1), an orifice (61 and opening formed by tip portion 3), the outer surface of the tip being optionally slightly concave (see Figs. 6 and 7), but does not disclose that a user can view the color of the product in the reservoir. However, the Lang reference discloses a similar applicator having a reservoir that is transparent (see col. 2, lines 33-37) so that the user can see the contents of the applicator. It would have

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been obvious to employ a transparent reservoir on the Gueret applicator in view of Lang so that the user can see the contents of the applicator.

Claims 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret in view of Lang as applied to claim 31 supra, and further in view of Trabattoni.

Regarding claims 6 and 8, the Gueret reference discloses an applicator as discussed supra, but does not disclose an opening in the body to receive a top portion of another container. However, the Trabattoni reference discloses a similar applicator whose body has an opening to receive a top portion of another container for convenient transport of nail polish. It would have been obvious to employ an opening in the body of the Gueret applicator to receive a top portion of another container in view of Trabattoni for convenient transport of nail polish. Regarding claims 7 and 9-14, although the Trabattoni reference does not disclose the other listed products, it would have been obvious to utilize the modified Gueret applicator to transport any of the other listed products as all such products are equally desirable to be transported for cosmetic purposes.

Claims 21-23, 25, 26, 37-39, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret in view of Lang as applied to claim 31 above, and further in view of Kapustin.

Regarding claim 21, the Gueret reference discloses a lip product applicator as discussed above, but does not disclose that the tip has a teardrop-shaped surface. However, the Kapustin reference teaches the use of a teardrop-shaped surface for applying product to a user's lips (see col. 3, line 49) for decorative purposes. It would

have been obvious to modify the tip of the Gueret applicator to have a teardrop-shaped surface in view of Kapustin for decorative purposes. Regarding claim 22, the tip is optionally slightly concave (see Figs. 6 and 7). Regarding claims 23, 25, 26, and 41, the tip optionally includes a plurality of canals 61 including a downward vertical canal and a horizontal canal (see Fig. 16 and col. 8, lines 58-62). Regarding claim 37, the Gueret reference discloses a lip product applicator as discussed above, but does not disclose that the tip has a teardrop-shaped surface. However, the Kapustin reference teaches the use of a teardrop-shaped surface for applying product to a user's lips (see col. 3, line 49) for decorative purposes. It would have been obvious to modify the tip of the Gueret applicator to have a teardrop-shaped surface in view of Kapustin for decorative purposes. Regarding claim 38, the tip is optionally slightly concave (see Figs. 6 and 7). Regarding claims 39 and 42, the tip optionally includes a plurality of canals 61 including a downward vertical canal and a horizontal canal (see Fig. 16 and col. 8, lines 58-62).

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret in view of Kapustin and Lang.

The Gueret reference discloses an applicator for applying product to a user's lips comprising a body 2 with a hollow reservoir (portion other than tip portions 31 and 3 containing product P, see Fig. 2), a tip (comprising portions 31, 3, and 6) having an outer surface (see Fig. 1), an orifice (61 and opening formed by tip portion 3), and means for discharging product 41, but does not disclose that the outer surface of the tip has a teardrop shaped outer surface or that a user can view the color of the product in

the reservoir. Regarding the teardrop shaped outer surface, the Kapustin reference teaches the use of a teardrop-shaped surface for applying product to a user's lips (see col. 3, line 49) for decorative purposes. It would have been obvious to modify the tip of the Gueret applicator to have a teardrop-shaped surface in view of Kapustin for decorative purposes. Regarding viewing of product in the reservoir, the Lang reference discloses a similar applicator having a reservoir that is transparent (see col. 2, lines 33-37) so that the user can see the contents of the applicator. It would have been obvious to employ a transparent reservoir on the Gueret applicator in view of Lang so that the user can see the contents of the applicator.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret in view of Lang as applied to claim 3 supra, and further in view of Green.

The Gueret reference discloses an applicator as discussed above and further including plug 82, but does not disclose that the plug is inserted into the orifice. However, the Green reference discloses a similar applicator wherein the plug is inserted into the orifice (see Fig. 4) for improved sealing of the orifice. It would have been obvious to modify the modified Gueret device so that the plug is inserted into the orifice in view of Green for improved sealing of the orifice.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret in view of Lang and Green as applied to claim 27 above, and further in view of Penn.

The Gueret reference discloses an applicator as discussed above, but does not disclose that the plug is adhered to the cap by a protrusion on the inside surface of the cap that is wider at its tip than its base and mates with the side of the plug opposite the

orifice. Instead, the protrusion is integral with the cap. However, the Penn reference discloses a cap with a sealing plug (Fig. 4) wherein the plug 37 is adhered to the 42 by a protrusion 43 on the inside surface of the cap that is wider at its tip 21 than its base and mates with the side of the plug opposite the end that is inserted into to the opening so that the plug can be made from a specialized plug material different from that of the cap. It would have been obvious to modify the modified Gueret applicator so that the plug is adhered to the cap by a protrusion on the inside surface of the cap that is wider at its tip than its base and mates with the side of the plug opposite the orifice in view of Penn so that the plug can be made from a specialized plug material different from that of the cap.

#### ***Response to Arguments***

Applicant's arguments filed 4/20/06 have been fully considered but they are not persuasive. Regarding claim 31, Applicant argues that the prior art does not disclose an applicator with a reservoir having a constant thickness and wherein a user can view the color of a product in the reservoir. However, as discussed in detail above it is the Examiner's position that the applicator of claim 31, including these features, is anticipated by the prior art. Regarding claim 32, Applicant argues that the prior art does not disclose an applicator whose driving surface has a product contact surface that contact the inner surface of the tip to remove as much product as possible from the reservoir. However, as discussed in detail above it is the Examiner's position that the applicator of claim 32, including this feature, is anticipated by the prior art. Regarding

claim 43, Applicant argues that the prior art does not disclose an applicator whose product contact surface is generally parallel to the inner surface of the tip. However, as discussed in detail above it is the Examiner's position that the applicator of claim 43, including this feature, is anticipated by the prior art. Regarding claim 44, Applicant argues that the prior art does not disclose an applicator whose tip outer surface is slightly concave. However, as discussed in detail above it is the Examiner's position that the applicator of claim 44, including this feature, is rendered obvious by the prior art. Regarding claim 45, Applicant argues that the prior art does not disclose an applicator whose tip outer surface is teardrop shaped. However, as discussed in detail above it is the Examiner's position that the applicator of claim 45, including this feature, is rendered obvious by the prior art. Regarding claim 46, Applicant argues that the prior art does not disclose an applicator whose driving member has a flat product contact surface across its entire surface. However, as discussed in detail above it is the Examiner's position that the applicator of claim 46, including this feature, is anticipated by the prior art. Regarding claim 47, Applicant argues that the prior art does not disclose an applicator whose driving member is a flat disk having generally parallel top and bottom surfaces. However, as discussed in detail above it is the Examiner's position that the applicator of claim 47, including this feature, is anticipated by the prior art. Applicant's arguments regarding claim 48 are moot as this claim is withdrawn from consideration as discussed above.

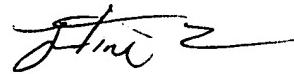
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter deVore whose telephone number is 571 272-4884. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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PdPd

  
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6/2/06